

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Regarding: Charles O. Townley
Serial No. 10/758455
Filing Date 01/15/2004
Docket No. THUMB-604DIV
For MODULAR BASAL THUMB JOINT IMPLANT

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Reply Brief for Appellant

Attention: On Appeal from Art Unit 3738
Examiner Brian E. Pellegrino

Commissioner for Patents, Alexandria, VA 22313-1450:

I certify that this correspondence is facsimile-transmitted
to the Patent and Trademark Office (571 273 8300) on 19 NOV 2008:

Christopher John Rudy: *Christopher John Rudy (SPP)* 11/19/2008.

In reply to the SEP 19 2008 EXAMINER'S ANSWER please consider
this in support of the patentability of the claims on appeal.

Versus the Examiner's Evidence Relied Upon

The Examiner chose bits of material out of context, and those
he misapplied or misapprehended. He improperly dismissed or
ignored other material of record.

Versus the Examiner's Grounds of Rejection

The reasoning behind the grounds of rejection remains as was
set forth in the 08/02/2007 final Office action, from which this
appeal is taken. Such is addressed by the Brief for Appellant
filed on February 8, 2008.

Versus the Examiner's Response to Argument

The Brief for Appellant, and the art and evidence made of
record, when taken as the whole it is, rebuts the Examiner's new
reasoning behind his rejections. The following is further noted:

Regarding the rejection of claims 21, 22, 25, 26, 28, 29, 40
and 41 over McLaughlin, the term, "large," although relative, is
clearly understood by the person of ordinary skill in the art,
and constitutes a fair and proper basis for comparison. The
pertinent ordinary artisan is well educated and experienced, and
he would recognize that a hip or shoulder joint and implants
therefor are large, extremely large, and inapplicable to art for
comparably smaller, much smaller, basal thumb joint. This is
verified of record by the Appellant such as set forth in the
Evidence Appendix, p. EA-4, first paragraph, through p. EA-5,
second paragraph (Pringle declaration: hip and shoulder art not
relevant because of size, configuration, and implant situs); and
the Board in parent application No. 09/352,472 found that weighty

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and convincing as set forth in the Related Proceedings Appendix, p. RPA 8, sole full paragraph (weight given to Pringle's verified statements), and p. RPA-20, second full paragraph (... Smith (hip art) ... not rendering parent basal thumb joint implant obvious). Moreover, again, McLaughlin's "head" 12 does not articulate, is taught to be fixed with screws, glue or bony ingrowth, and has discontinuities on its surface such as screw holes or a roughness for gluing or bony ingrowth that make it so that it itself cannot articulate. What is more, if it could or does articulate, i.e., if it is not fixed, it makes the entire joint inoperable for its intended purpose, and thus inapplicable art under Sec. 103(a). See, United States v. Adams, 383 U.S. 39 [148 USPQ 479, 483]; In re Gordon, 733 F.2d 900 [221 USPQ 1125, 1127] (Fed. Cir. 1984). No facts or verified statements support the Examiner's position.

The dome "head" 12 of McLaughlin's device, again, has screw holes in its surface. These, by definition as well as practice, render its surface discontinuous as to its sphericity.

Claim 21 requires that, when the stem is "attached to the head, projects from the head." Thus, a direct attachment feature of stem to head is expressly present in such a claim. Moreover, McLaughlin does not disclose the invention as claimed, which, aside from the plain import of it versus the claims, is evidenced by the fact that no rejection with it stands under 35 USC 102(b). The intervening structure of McLaughlin's device is highly relevant, not irrelevant, to patentability. The teachings of a reference as a whole must be considered. See, e.g., In re Hedges, 783 F.2d 1038 [228 USPQ, 685, 687] (Fed. Cir. 1986). Accordingly, in contrast to that which the Examiner states in his answer, this direct attachment feature remains a requirement of dependent claims 22, 25, 26, 28 and 29 (and, as noted below, independent claim 40 and claim 41 dependent thereon), the details of which are found therein with arguments and declaration support provided in the Brief for Appellant to address the Examiner's misconceptions and errors of law. Moreover, as explained in the Brief for Appellant, the teachings of McLaughlin as a whole teach away from the present claims, which remains strong evidence of nonobviousness. See, Adams, 383 U.S. 39 [148 USPQ at 483-484]; KSR International Co. v. Teleflex Inc., 550 U.S. ____ [82 USPQ2d 1385, 1399] (2007); Hedges, 783 F.2d 1038 [228 USPQ at 687].

Claim 40 also requires a size limitation, i.e., that which concerns implantability as a basal thumb joint implant in the definitely claimed bone stocks. It matters not that an "expert," as the Examiner asserts, could modify McLaughlin. The proper standard is that of a person of ordinary skill in the pertinent art of the claims under consideration. See, e.g., Environmental Designs Ltd. v. Union Oil Company of California, 713 F.2d 693 [218 USPQ 865, 868-869] (Fed. Cir. 1983); Ex parte Hiyamizu, 10 USPQ2d 1393, 1394 (Bd. Pat. App. Int. 1988). Furthermore, this claim requires, "head and stem modularity such that the head is removably attachable to the stem." This claim language, in light

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of the supporting descriptions and drawings, which must be considered in construing the claim, means the head can be attached to and detached from, i.e., "is removably attachable," to the stem. Compare, Phillips v. AWH Corp., 415 F.3d 1303 [75 USPQ2d 1321, 1325-1335] (Fed. Cir. 2005) (en banc).

Claim 41, by virtue of its dependence on claim 40, requires direct attachment, and, moreover, an acute angle of projection of the stem to head. As noted above and plain from a fair reading of the whole of McLaughlin, McLaughlin does not suggest such a feature in a basal thumb joint implant; Further, it is nonanalogous art and would be inoperable for its intended purpose with its fixed head if viewed as the Examiner proposes.

The old applied Townley patent relates to a hip joint implant as does the art of McLaughlin. Also the segmented device of McLaughlin relates to a shoulder. Both the hip and shoulder are large enarthrodial joints. The basal thumb joint in nature is a small, saddle joint. These are fundamentally different and do not have application together in the present art. Compare, Evidence Appendix, p. EA-4, first paragraph, through p. EA-5, second paragraph (Pringle declaration: hip and shoulder art not relevant because of size, configuration, and implant situs); Related Proceedings Appendix, p. RPA 8, sole full paragraph (weight given to Pringle's verified statements), and p. RPA-20, second full paragraph (... Smith (hip art) ... not rendering parent basal thumb joint implant obvious).

Moreover, as applies to claim 23, the "clear" teaching espoused by the Examiner to have come from the nonmodular hip joint of Townley to apply with the segmented, multipolar hip or shoulder joint of McLaughlin so as to create the claimed modular basal thumb joint implant with its tri-flanged stem comes only through the use of impermissible hindsight, finding bits and pieces of the claim in the applied art. This is improper. See, e.g., Grain Processing Corporation v. American Maize Products, 840 F.2d 902 [5 USPQ2d 1788, 1792] (Fed. Cir. 1988). Even so, if these patents are considered, there yields at best ambiguity from their many, varied teachings, which is insufficient to establish obviousness. See, In re Roemer, 258 F.3d 1303 [59 USPQ2d 1527, 1531] (Fed. Cir. 2001). In fact, if combined and applicable, as noted in the Brief for Appellant, these references teach away from the claim, which is strong evidence of nonobviousness. See, Adams, 383 U.S. 39 [148 USPQ at 483-484]; KSR, 550 U.S. ____ [82 USPQ2d at 1399] (2007); Hedges, 783 F.2d 1038 [228 USPQ at 687].

The Examiner has avoided addressing the issue that the total finger joint of Lane is fundamentally nonanalogous art to that of a modular basal thumb joint implant. As pointed out in the Brief for Appellant, page 10, in the parent application the Examiner admitted that finger joint art and basal thumb joint art form patentably distinct areas. Without addressing the particulars of proper applicability, the Examiner proposes to apply Lane with

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McLaughlin anyhow. This is improper. As submitted in the Brief for Appellant, neither patent is applicable. See, In re Oetiker, 977 F.2d 1443 [24 USPQ 1443, 1445-1446] (Fed. Cir. 1992). What is more, the Examiner failed to address the situation where, as submitted in the Brief for Appellant, if these patents are considered, there yields at best ambiguity from their many, varied teachings, which is insufficient to establish obviousness as held in Roemer, 258 F.3d 1303 [59 USPQ2d at 1531], and the fact that their disclosures would teach away from the claimed invention, which is calls for nonobviousness, as held in Adams, 383 U.S. 39 [148 USPQ at 483-484]; KSR, 550 U.S. ____ [82 USPQ2d at 1399] (2007); and Hedges, 783 F.2d 1038 [228 USPQ at 687]. Even so, to say as the Examiner has done that changing the curvature of the stem of McLaughlin's implant would not materially affect its performance is contrary to the teachings of McLaughlin. See, FIG. 1, with its straight "stem" 13 inserted into the straight portion of the medullary canal of the femur. With a "stem" curved as proposed by the Examiner, McLaughlin's device would not be able to be inserted into the femur and would be inoperable, making it inapplicable. See, Adams, 383 U.S. 39 [148 USPQ at 483]; Gordon, 733 F.2d 900 [221 USPQ at 1127].

As submitted in the Brief for Appellant, the total hip joint implant of Abouaf et al. adds nothing to the divergent teachings of McLaughlin to remedy the deficiencies of McLaughlin as pertains to the fundamental structures required by claims 31, 32 and 34-36 as claims dependent on 21, 22, 28 or 29; none of Abouaf et al., like Townley, and McLaughlin is related sufficiently to the pertinent art to be applied under the meaning of Sec. 103(a); and even if applied there teachings are so divergent and many that ambiguity results at best, which, however, is insufficient to establish obviousness. The Examiner states that Abouaf et al. would not alter the operability of McLaughlin; thus, if modified in the manner proposed by the Examiner, McLaughlin would be inoperable for its intended purpose, Abouaf et al. would not add anything to McLaughlin to make it operable for its intended purpose. Moreover, the Examiner alludes to a Morse taper; if employed in the device of McLaughlin, such a taper would stop all rotation between pieces, thus "freezing" the device and making it inoperable for its intended purpose. An inoperable device cannot be used to establish obviousness. See, Adams, 383 U.S. 39 [148 USPQ at 483]; Gordon, 733 F.2d 900 [221 USPQ at 1127].

Regarding claim 37, it is highly relevant that the Swanson device is of one piece. If, for the sake of argument, Swanson is combined with the hip or shoulder joint of McLaughlin, this shows the wisdom of the prior art that when size matters, i.e., when a large device would be reduced in size for implantation as a basal thumb joint implant, the implant should be made of one piece, not of plural pieces. This teaches away from the present invention, and is strong evidence of nonobviousness. See, Adams, 383 U.S. 39 [148 USPQ at 483-484]; KSR, 550 U.S. ____ [82 USPQ2d at 1399] (2007); Hedges, 783 F.2d 1038 [228 USPQ at 687]. Moreover, as

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noted in the Brief for Appellant, the combination is improper; and, if for the sake of argument the references are combined, at best ambiguity results, which does not establish obviousness.

Regarding claim 42, generally according to the reasoning of the Examiner, if the Cobalt-Chromium-Molybdenum metal alloy powder (not a ceramic) of the ASTM were applied to a device of McLaughlin, it would enhance the attachment of the McLaughlin device. Since the "head" of McLaughlin's device is fixed to the bone in a prepared acetabular cavity, this would make the device of McLaughlin even more unfit for articulation in such a cavity, hence, more inoperable, and more inapplicable than noted before. Only operable art can be applied. See, Adams, 383 U.S. 39 [148 USPQ at 483]; Gordon, 733 F.2d 900 [221 USPQ at 1127].


Overall, the Examiner failed to take into account or give weight to the declaration evidence of record. This includes not only factual matters and expert opinions rebutting the standing rejections under Sec. 103(a) but also, as may be applicable, evidence of secondary considerations. Such evidence must be given weight. See, e.g., Graham v. John Deere Co. of Kansas City, 383 U.S. 1 [148 USPQ 459, 466-467] (1966); In re Altenpohl, 500 F.2d 1151 [183 USPQ 38, 44 (CCPA 1974)]; In re Sernaker, 702 F.2d 989 [217 USPQ 1, 7] (Fed. Cir. 1983); In re Piasecki, 745 F.2d 1468 [223 USPQ 785, 790] (Fed. Cir. 1984).

Conclusion

Reversal of the Examiner's rejections remains in order.

Respectfully,

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